



PATENT
Attorney Docket No. 213839-00013
24
JW/B
05/11/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: McCafferty, *et al.*

Serial No.: 09/726,219

Filed: November 28, 2000

Title: Methods for Producing
Members of Specific Binding
Pairs

Group Art Unit: 1627

Examiner: P. Ponnaluri

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop DD, Commissioner for Patents, Alexandria, VA 22313-1450, on this date.

05/05/03

Date

David W. Clough, Ph.D.
David W. Clough, Ph.D.
Registration No. 36,107

**FIRST SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
PURSUANT TO 37 C.F.R. § 1.97-1.99
FILED WITH PETITION TO EXPUNGE
PURSUANT TO 37 C.F.R. § 1.59**

Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Information Disclosure Statement is being submitted pursuant to the applicants' duty of candor and in particular to the applicants' duty to disclose, under MPEP §2001.06(c), information from related litigation such as the charges of inequitable conduct in the parent of the present application, now U.S. Patent No. 5,969,108 (the '108 patent). Applicants request that the documents listed on the attached Form PTO/SB/08A be made of official record in the above-identified application and considered by the Examiner. Our check in the amount of \$180 is also enclosed pursuant to 37 C.F.R. § 1.17(p).

Some of the documents being submitted are subject to a protective order in Civil Action No. 1:00 CV 00146 and are being submitted in a sealed, clearly labeled envelope for consideration under MPEP § 724. A Petition to Expunge under 37 C.F.R. § 1.59, along with

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the fee of \$130 pursuant to 37 C.F.R. § 1.17(h) are also enclosed herewith. If the submitted documents are found not to be important in deciding whether to allow the application to issue as a patent, applicants respectfully request that the Petition to Expunge under 37 C.F.R. § 1.59 be granted and the documents identified below be returned to the attorney for applicant.

1. Agreement between Medical Research Council, Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, dated 1/7/97 (financial terms redacted);
2. Chiswell memo, dated July 30, 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995; and
3. Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, 8/1/91 (financial terms redacted).

This same Supplemental Information Disclosure Statement is being filed simultaneously in related application nos. 09/196,522; 09/196,673; 09/309,639; 09/416,902; 09/196,586; 09/417,479; 09/706,507; and 09/726,219. Each of these related applications is currently under examination by Examiner Ponnaluri. In view of the filing of the Petition to Expunge, applicants are transmitting a single copy of the cited references for consideration in each of the related applications.

**Inequitable Conduct Allegations Involving
U.S. Patent No. 5,969,108 (parent of the present application)**

The following is a brief summary of the allegations being made by MorphoSys AG with respect to inequitable conduct in obtaining the '108 patent. MorphoSys has alleged inequitable conduct on the part of Cambridge Antibody Technology Limited, ("CAT"), one of the assignees of the '108 patent, in obtaining the '108 patent. The subject matter claimed in the '108 patent generally relates to the display of single chain antibodies on the surface of filamentous bacteriophage.

One of the bases for the allegation of inequitable conduct is that the applicants did not disclose to the U.S. Patent & Trademark Office a National Institute's of Health ("NIH") grant application by Dr. George Smith relating to the display of small peptides on the surface of phage and which contains a prophetic disclosure of the display of single chain antibodies on the surface of phage which Dr. Smith characterized as speculative in the text of the grant.

Documents (including deposition testimony) submitted herewith relate *inter alia* to the specific allegations made by MorphoSys with regard to this issue, including communications between CAT personnel and their attorneys relating to their knowledge of the existence and public availability of the Smith grant application, and the allegedly cumulative nature of the application in view of what was already before the Patent Office and Dr. Smith's own characterization of what would constitute the invention of the display of single chain antibodies on phage made in a "Declaration" several years after his receipt of the NIH grant.

There is disagreement between CAT and MorphoSys regarding *inter alia* the actual public availability of a Smith grant application, its alleged cumulative and speculative nature in view of material already before the U.S. Patent & Trademark Office and the problems cited by Dr. Smith in his discussion of the display of single chain antibodies on phage in the grant application.

An allegation has also been made that CAT engaged in inequitable conduct by not disclosing to the Patent Office the Smith grant application as relevant to rebut arguments made to the PTO that the art taught away from the display of large peptides on the surface of phage. Nevertheless, the Examiner of the '108 case found that the applicants' arguments regarding that issue had already been rebutted by U.S. Patent No. 5,427,908 to Dower *et al.*, which was already of record in that case and is of record in the present application.

MorphoSys has further alleged that CAT has committed inequitable conduct for their alleged failure to point out the inventor and invention date of each claim that was not commonly owned by CAT and The Medical Research Council ("MRC"), both assignees of the '108 patent, at the time a later invention was made to allow consideration of the applicability of 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. § 103(a). MorphoSys alleges that CAT has failed to show that the subject matter and the claims were, at the time the invention was made, commonly owned. CAT's position supported by deposition testimony (attached herewith) is that there was a clear understanding that the subject matter of each and every claim was commonly owned at all times and the later written agreements submitted herewith simply memorialized the basic understanding between CAT and MRC.

The following documents are being submitted herewith which were recently filed, held or are relevant to the litigation involving the parent of this application in the U.S.

District Court District of Columbia (U.S. District Court, District of Columbia, Civil Action No. 1:00 CV 00146).

1. First Amended Complaint, filed March 8, 2002;
2. Cambridge Antibody Technology Limited's Answer to First Amended Complaint, filed March 22, 2002;
3. Redacted Agreement between Medical Research Council, Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, dated 1/7/97 (**Subject to the Petition to Expunge**);
4. Deposition Transcript of David W. Clough, taken April 19, 2002;
 - a. E. I. du Pont de Nemours & Co. v. Cetus Corp., 19 USPQ2d 1174, (DC D/ N.Cal. 1990) cited in Deposition Transcript of David W. Clough, taken April 19, 2002;
 - b. OddzOn Products Inc. v. Just Toys Inc., 43 USPQ2d 1641 (CAFC 1997), cited in Deposition Transcript of David W. Clough, taken April 19, 2002;
5. Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002;
6. Deposition Transcript of Dr. David Chiswell, taken April 29, 2002;
7. Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002;
8. Volume I – Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002;
9. Volume II – Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002;
10. Chiswell memo, dated July 30, 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995 (**Subject to the Petition to Expunge**);
11. Declaration of George P. Smith Under 37 C.F.R. § 1.132, executed June 30, 1995 (submitted during the prosecution of U.S. Application No. 08/322,352);

12. Declaration of Professor Brian K. Kay, Ph.D., executed June 28, 1998 (submitted during the prosecution of European Patent Application No. 91913039.3);
13. Abstract of George P. Smith Grant No. 1R01GM41478-01A1.
14. Smith Grant Application, dated November 1, 1988; and
15. Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, 8/1/91 (**Subject to the Petition to Expunge**).
16. Fax from John McCafferty (of Cambridge Antibody Technology Limited) to S. Walton (of Mewburn Ellis) Re: Smith Grant Application.
17. E-mail message from John McCafferty (of Cambridge Antibody Technology Limited) to Brian Kay Re: Smith Grant Application.
18. Letter from John McCafferty (of Cambridge Antibody Technology Limited) to Craig Palmer (of Academic Press) Re: Smith Grant Application.
19. Fax to John McCafferty (of Cambridge Antibody Technology Limited) from Craig Panner (of Academic Press) dated June 10, 1996.
20. Smith, G. P., "1988 – A Year of Discovery", *Phage Display of Peptides and Proteins*, Academic Press, Inc. (1996), pp. xvii-xix.
21. Northern Telecom Inc. v. Datapoint Corp., 15 USPQ 1321 (CAFC 1990).

Documents 1-12 and 15 are individually listed below with cites to the relevant testimony.

First Amended Complaint, filed March 8, 2002

Page	Line	
6	1	Allegations regarding Smith grant/
thru		inequitable conduct
21	12	

**Cambridge Antibody Technology Limited's
Answer to First Amended Complaint, filed March 22, 2002**

Page	Line	
7	8	Response to allegations regarding Smith grant/
	thru	inequitable conduct
29	22	

Deposition Transcript of David W. Clough, taken April 19, 2002

Page	Line	
21	10	Testimony regarding Smith grant
	thru	
25	10;	
27	1-15;	
29	10	
	thru	
32	24;	
33	11	
	thru	
40	20;	
46	4-10;	
55	22	
	thru	
57	16;	
65	10	
	thru	
66	14;	
68	10	
	thru	
84	24;	
88	20	
	thru	
95	5;	
96	16-19;	
97	22	
	thru	
99	6;	
100	15-24;	
101	12-21;	
102	22	
	thru	
104	24;	

Deposition Transcript of David W. Clough, taken April 19, 2002 (Continued)

Page	Line	
105	13	Testimony regarding Smith grant
	thru	
108	4;	
108	13-22;	
109	14-20	
111	1	
	thru	
112	3;	
123	3-15;	
125	1	
	thru	
131	2;	
131	12	
	thru	
132	8;	
141	12-15;	
142	3-15;	
148	9	
	thru	
152	7;	
153	10	
	thru	
154	14;	
155	14	
	thru	
156	9;	
176	8-24	
105	13	Testimony regarding '96 knowledge of Smith grant
	thru	
109	20	
171	15	
	thru	
175	12	
Page	Line	
176	18	Testimony regarding DuPont v. Cetus
	thru	
177	20	
Page	Line	
179	14-15	Testimony regarding Oddzn Products v. Just Toys Inc.

Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002

Page	Line	
31	8	Testimony regarding Smith grant
	thru	
39	17;	
40	4	
	thru	
49	15;	
50	25	
	thru	
53	25;	
61	20	
	thru	
62	12;	
64	5	
	thru	
65	25;	
67	6	
	thru	
68	8;	
92	1-22;	
100	24	
	thru	
101	13;	
104	10-17;	
106	12-21;	
111	7	
	thru	
112	12;	
132	12-25;	
141	21	
	thru	
142	16;	
143	14	
	thru	
146	25;	
148	23	
	thru	
149	1;	
155	14-22;	
157	8	
	thru	
158	4;	
162	8-20;	

Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002

Page	Line	
166	10	Testimony regarding Smith grant
	thru	
167	12;	
183	2-23.	

Deposition Transcript of Dr. David Chiswell, taken April 29, 2002

Page	Line	
119	23	Testimony regarding Smith grant
	thru	
124	1;	
128	5	
	thru	
129	5;	
204	19	
	thru	
209	22	

Page	Line	
37	2	Testimony regarding Chiswell memo
	thru	
66	4;	
94	17	
	thru	
96	2	

Page	Line	
None		Testimony regarding '96 knowledge of Smith grant

Page	Line	
157	7	Testimony regarding common ownership
	thru	
158	17;	
215	19	
	thru	
219	15	

Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002

Page	Line	
123	11-14;	Testimony regarding Smith grant
130	22	
	thru	
139	14.	
Page	Line	
None		Testimony regarding '96 knowledge of Smith grant
Page	Line	
74	1	Testimony regarding common ownership
	thru	
77	22	
79	16	
	thru	
80	16	
82	1-11	
181	18	
	thru	
182	24	
222	3	Testimony regarding common ownership
	thru	
225	13	

Volume I

Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002

Volume II

Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002

Page	Line	
16	8	Testimony regarding Smith grant
	thru	
18	2;	
31	20	
	thru	
59	23;	
64	11	
	thru	
91	6;	

Volume I
Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002
Volume II
Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002
(Continued)

Page	Line	
93	25	Testimony regarding Smith grant:
	thru	
95	9;	
95	19	
	thru	
96	4;	
97	19	
	thru	
106	21;	
108	14	
	thru	
109	23;	
110	12	
	thru	
111	1;	
132	17-23;	
133	15	
	thru	
140	25;	
165	21	
	thru	
166	18;	
170	1-9;	
173	16	
	thru	
176	11;	
199	6	
	thru	
208	23;	
228	11-13;	
230	8-16;	
231	7-9;	
232	25	
	thru	
243	22;	
246	16	
	thru	
247	10;	

Volume I
Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002
Volume II
Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002
(Continued)

Page	Line	
249	23	Testimony regarding Smith grant:
	thru	
257	22;	
267	5	
	thru	
268	18;	
270	21	
	thru	
277	22;	
285	2	
	thru	
289	19;	
321	24	
	thru	
322	13;	
322	18-23;	
323	5	
	thru	
328	11	
Page	Line	
82	17	Testimony regarding '96 knowledge of Smith grant:
	thru	
90	8;	
95	19	
	thru	
96	4;	
97	19	
	thru	
101	5;	
103	3	
	thru	
106	21;	
108	14	
	thru	
111	1;	

Volume I

Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002

Volume II

Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002
(Continued)

Page	Line	
133	15	Testimony regarding '96 knowledge of Smith grant:
	thru	
140	25;	
205	5	
	thru	
208	23;	
271	19	
	thru	
277	22;	
285	2	
	thru	
289	19; and	
321	24	
	thru	
328	11	
Page	Line	
179	22	Testimony regarding common ownership:
	thru	
184	17;	
186	16	
	thru	
191	8;	
192	22	
	thru	
195	19	

**Chiswell memo, dated July 30, 1990,
(transmitting a copy of the Collaborative Agreement between Cambridge Antibody
Technology and The Medical Research Council, dated July 27, 1995)
(Subject to Petition to Expunge)**

Declaration of George P. Smith Under 37 C.F.R. § 1.132

Page	Line
2	7-9; Inequitable conduct
4	3-9

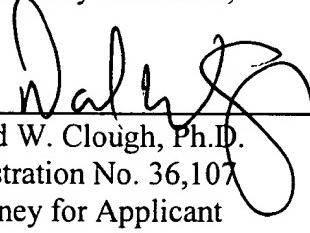
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Finally, attorney for applicants submit herewith a reference (Il'ichev, A.A., *et al.*, "M13 Filamentous Bacteriophage in Protein Engineering", *Molekulyarnaya Biologiya*, Vol. 24, No. 2, pp. 530-535, (March-April 1990)(two versions – one in Russian (with a one-page abstract) and a translation of the same reference) and a patent which were recently brought to applicants' attention.

In addition, a copy of the references cited made necessary by ongoing proceedings in the European Patent Office in connection with a relative European application, which were brought to our attention less than three months prior to the filing of this Information Disclosure Statement.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 50-1214. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-1214.

Respectfully submitted,



David W. Clough, Ph.D.
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Attorney for Applicant

May 5, 2003
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The PTO did not receive the following
listed item(s) the check



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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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Sheet 1 of 10

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)								Docket Number 213839-00013	Application Number 09/726,219									
								Applicant McCafferty et al.										
								Filing Date November 28, 2000								Group Art Unit 1627		
								U. S. PATENT DOCUMENTS										
EXAMINER INITIAL	DOCUMENT NUMBER							DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROP.						
A1	6	3	3	1	4	1	5		Cabilly et al.	435	69.6	6/10/88						
A2	07/	2	4	0	1	6	0	3/22/90	Ladner application									
FOREIGN PATENT DOCUMENTS																		
		DOCUMENT NUMBER				DATE	COUNTRY		CLASS	SUB CLASS	Translation							
											Yes	No						
B1	WO 88/01649				3/10/88	PCT												
B2	GB9022845.3				10/19/90	Great Britain												
B3	GB9024503.6 patent application				11/12/90	Great Britain												
B4	GB 9104744.9 patent application				3/6/91	Great Britain												
B5	EP-A-0 368 684				5/16/90	Great Britain												
B6	GB9015198.6 priority document				7/10/90	Great Britain												
B7	GB 9022845.3 priority document				10/19/90	Great Britain												
B8	GB 9104744.9 priority document				3/6/91	Great Britain												
B9	GB9110549.4 priority document				5/15/91	Great Britain												
B10	EP-B-0 349 578 B1				11/30/94	Great Britain												
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)																		
C1	First Amended Complaint, Filed March 8, 2002 - Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (24 pages) (U.S. District Court, District of Columbia)(signed by John S. Skilton, Attorney for Plaintiff.)																	
C2	Cambridge Antibody Technology Limited's Answer to First Amended Complaint, Filed March 22, 2002 - Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia)(signed by Brian H. Corcoran, Attorney for Defendant).																	
EXAMINER								DATE CONSIDERED										
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.																		

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Sheet 2 of 10

Substitute for form 1449A/PTO		Docket Number 213839-00013	Application Number 09/726,219
INFORMATION DISCLOSURE		Applicant McCafferty et al.	
STATEMENT BY APPLICANT		Filing Date November 28, 2000	Group Art Unit 1627
(Use several sheets if necessary)		OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)	
	C3	Il'ichev, A.A., et al., "M13 Filamentous Bacteriophage in Protein Engineering", Molekulyarnaya Biologiya, Vol. 24, No. 2, pp. 530-535, (March-April 1990).	
	C4	Ilyichev, A.A., et al., "M13 Filamentous Bactiophage for Protein Engineering", Molekulyarnaya Biologiya, Vol. 24, No. 2, pp. 530-535, (March-April 1990). (In Russian with Translated Abstract)	
	C5	Redacted Agreement Between Medical Research Council and Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, made 01 January 1997	
	C6	Deposition Transcript of David W. Clough, taken April 19, 2002 (Morphosys AG v. Cambridge Antibody Technology Limited, U.S. District Court, Northern District of Illinois, Eastern Division).	
	C7	E.I. du Pont de Nemours v. Cetus Corp., 19 USPQ2d 1174, (DC N.Cal. 1990).	
	C8	OddzOn Products Inc. v. Just Toys Inc., 43 USPQ2d 1641(CAFC 1997).	
	C9	Deposition Transcript of George P. Smith, Ph.D., taken 14 May 2002, Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)	
	C11	Deposition Transcript of Dr. David Chiswell, taken 29 April 2002; Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)	
	C12	Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002; Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)	
	C13	Vol. I - Deposition Transcript of Sean Malcolm Walton, taken 01 May 2002, Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)	
EXAMINER		DATE CONSIDERED	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.			

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Sheet 3 of 10

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)		Docket Number 213839-00013	Application Number 09/726,219
		Applicant McCafferty et al.	
		Filing Date November 28, 2000	Group Art Unit 1627

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

C14	Vol. II - Deposition Transcript of Sean Malcolm Walton, taken 02 May 2002, Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.)
C15	Chiswell memo, dated 30 July 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995.
C16	Declaration of George P. Smith, Ph.D., Under 37 C.F.R. § 1.132, executed 30 June 1995 (submitted during the prosecution of U.S. Application No. 08/322,352).
C17	Declaration of Brian K. Kay, Ph.D., executed 28 June 1998, (submitted during the prosecution of European Appln. No. 91913039.3)
C18	Abstract of George P. Smith, Grant No. 1R01GM41478-01A1, Project Start Date: July 1, 1989, Dept. of Health & Human Services.
C19	Smith Grant Application, entitled: "Filamentous Phage Physiology", dated November 1, 1988
C20	Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, dated 01 August 1991 (Redacted).
C21	Fax from John McCafferty (of Cambridge Antibody Technology Limited) to Sean Walton (of Mewburn Ellis) regarding the Smith grant application.
C22	E-mail message from John McCafferty (of Cambridge Antibody Technology Limited) to Brian Kay regarding the Smith grant application
C23	Letter to Craig Panner (of the Academic Press) from John McCafferty (Cambridge Antibody Technology Limited) regarding the Smith grant application
C23 A	Fax to John McCafferty, Ph.D. (of Cambridge Antibody Technology Limited) from Craig Panner (of Academic Press) dated June 10, 1996.
C24	Smith, G. P., "1988 - A Year of Discovery", <i>Phage Display of Peptides and Proteins</i> , Academic Press, Inc. (1996), pp. xvii-xix.
C25	Northern Telecom Inc. v. Datapoint Corp., 15 USPQ 1321., (CAFC 1990).
C26	Letter of Dr. Smith Re: NIH grant proposals, Dated June 27, 1997

EXAMINER	DATE CONSIDERED
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1600/2000

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if no conformance and not considered. Include copy of this form with next communication to the applicant.



PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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Sheet 4 of 10

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)		Docket Number 213839-00013	Application Number 09/726,219
		Applicant McCafferty et al.	
		Filing Date November 28, 2000	Group Art Unit 1627
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)			
	C27	Barbas and Lerner "Combinatorial Immunoglobulin Libraries on the surface of phage (Phabs): rapid selection of anti-specific fabs." Methods: a companion to methods in Enzymology Vol. 2 (2): 119-124 (1991).	
	C28	Interlocutory Decision in Opposition Proceedings to the European Patent EP-B-0589877 dated April 15, 2002 (reference number SMW/CP9503921)	
	C29	Notice of Appeal to the European Patent EP-B-0589877 from Dyax Corp., filed June 17, 2002	
	C30	Communication from EPO on Notice of Appeal filed by Dyax, issued October 21, 2002	
	C31	Notice of Appeal to the European Patent EP-B-0589877 from BioInvent Therapeutic AB, filed June 14, 2002	
	C32	Appeal No. T0639/02-334 from BioInvent Therapeutic AB to the European Patent EP-B-0589877, filed August 22, 2002	
	C33	Notice of Appeal to the European Patent EP-B-0589877 from MorphoSys AG filed June 20 2002 and Grounds of the Appeal filed August 22, 2002	
	C34	Notice of Appeal filed June 24, 2002 and Grounds of Appeal filed August 22, 2002 from Cambridge Antibody Technology Limited against the Decision of the Opposition Division	
	C35	Notice of Opposition to the European Patent EP-B-0589877 from BioInvent International AB, filed October 24 2002	
	C36	Document D80 in Appeal No. T0639/02-334: HHS' Freedom of Information Act (FOIA) regulations: table of contents, 5.1, 5.2, 5.3, 5.5, 5.21, 5.22, 5.24, 5.31, 5.32, 5.33, 5.34, 5.35, 5.51, 5.61 and 5.65	
	C37	Document D81 in Appeal No. T0639/02-334: Smith Declaration	
	C38	Document D82 in Appeal No. T0639/02-334: Copy of Grant Application GM 41478 and renewal applications supplied by the DHH	
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		Applicant McCafferty et al.	
		Filing Date November 28, 2000	Group Art Unit 1627

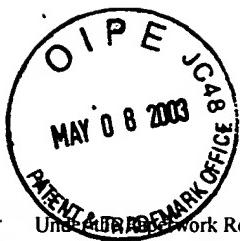
OTHER DOCUMENTS

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C39	Document D83 in Appeal No. T0639/02-334: Letter dated 26 August 1999 from Cambridge Antibody Technology Ltd in opposition proceedings against EP 0 527 839
C40	Document D85 in Appeal No. T0639/02-334: Proprietor's letter of 12 November 1997 and amended claims
C41	Document D86 in Appeal No. T0639/02-334: EP 0774 511 A1
C42	Document D87 in Appeal No. T0639/02-334: Proprietor's letter of 15 November 2000
C43	Document D88 in Appeal No. T0639/02-334: Grounds of Appeal dated 22 August 2002 from present opponent in opposition proceedings against EP 0589 877
C44	Document D89 in Appeal No. T0639/02-334: OD's Written Interlocutory Decision in opposition proceedings against EP 0 589 877
C45	Document D90 in Appeal No. T0639/02-334: Marvin & Hohn (1969). Bacteriological Rev 33(2), 172-209
C46	Document D91 in Appeal No. T0639/02-334: Better et al. (1988). Science 240, 1041-1043
C47	Document D92 in Appeal No. T0639/02-334: Sambrook & Russel (2001). Molecular cloning: a laboratory manual 3rd Edition, Cold Spring Harbor Press; particular pages 18.115 to 18.122 "Filamentous phage display"
C48	Notice of Opposition to the European Patent EP-B-0589877 from Crucell Holland B.V, filed October 30 2002
C49	Document D13: Communication of the European Office of 28 June 2001
C50	Document D17: Vieira and Messing (1987), Methods Enzymol. 153, 3-11

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		Applicant McCafferty et al.	
		Filing Date November 28, 2000	Group Art Unit 1627

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C51	Document D27: Details of Smith Grant application and second and third year renewals thereof as provided by the DHHS in response to a Freedom to Information Act (FOIA) request
C52	Notice of Opposition to the European Patent EP-B-0589877 from Dyax Corp.
C53	Document D1: EPO register print-out for the patent application with file history information
C54	Document D3: Claims filed with the divisional application
C55	Document D7: Pluckthun and Skerra, "Expression of functional antibody Fv and Fab fragments in Escherichia coli," Methods in Enzymology, Vol. 178 (1989), pages 497-515
C56	Document D8: Hoogenboom et al., "Multi-subunit proteins on the surface of filamentous phage: methodology for displaying antibody (Fab) heavy and light chains," Nucleic Acids Research, Vol 19, No. 15 (1991), pages 4133-4137.
C57	Notice of Opposition to the European Patent EP-B-0589877 from MorphoSys, filed October 30 2002
C58	Document D1: Genentech, US Patent Application 07/621,667, priority document to EP 92902109.5
C59	Opposition to European patent EP-B-0589877, cited opposition document D2: Nelson et al. "Filamentous phage DNA cloning vectors: a noninfective mutant with a nonpolar deletion in gene III", Virology 108: 338-350 (1981)
C60	Opposition to European patent EP-B-0589877, cited opposition document D3: McCoy and Khorana "Introduction and characterization of amber mutations in the bacteriorhodopsin gene", J. Bio. Chem. 258: 8456-8461 (1983)
C61	Opposition to European patent EP-B-0589877, cited opposition document D5: Bullock et al. "XL1-blue: a high efficiency plasmid transforming recA Escherichia coli strain with beta-galactosidase selection", Bio Techniques 5: 376-378 (1987)
C62	Opposition to European patent EP-B-0589877, cited opposition document D6: Schnee et al. "Construction and expression of a recombinant antibody-targeted plasminogen activator", Proc. Natl. Acad. Sci. USA 84:6904-6908 (1987)
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		Applicant McCafferty et al.	
		Filing Date November 28, 2000	Group Art Unit 1627

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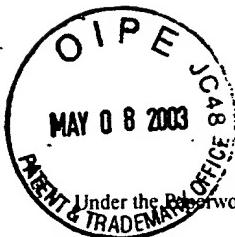
	C63	Opposition to European patent EP-B-0589877, cited opposition document D9: De La Cruz et al. "Immunogenicity
		and epitope mapping of foreign sequences via genetically engineered filamentous phage", <i>J. Bio. Chem.</i> 263: 4318-4322 (1988)
	C64	Opposition to European patent EP-B-0589877, cited opposition document D15: Parmley and Smith "Filamentous
		fusion phage cloning vectors for the study of epitopes and design of vaccines", <i>Adv. Exp. Med. Biol.</i> 251: 215-218 (1989)
	C65	Opposition to European patent EP-B-0589877, cited opposition document D18: Chaudhary et al. "A recombinant
		immunotoxin consisting of two antibody variable domains fused to <i>Pseudomonas exotoxin</i> ", <i>Nature</i> 339: 394-397 (1989)
	C66	Opposition to European patent EP-B-0589877, cited opposition document D23: US 517 659 "Affymax priority
		document", entitled "Recombinant Library Screening Methods", priority document filed 1 May 1990 for EP-A-0 527 839 (Article 54(3) EPC)
	C67	Opposition to European patent EP-B-0589877, cited opposition document D26: Scott and Smith "Searching for
		peptide ligands with an epitope library", <i>Science</i> 249: 386-389 (1990)
	C68	Opposition to European patent EP-B-0589877, cited opposition document D27: Devlin et al. "Random peptide
		libraries: a source of specific protein binding molecules", <i>Science</i> 249: 404-405 (1990)
	C69	Opposition to European patent EP-B-0589877, cited opposition document D37: Markland et al. "Design,
		construction and function of a multicopy display vector using fusions to the major coat protein of bacteriophage M13", <i>Gene</i> 109: 13-19 (1991)
	C70	Opposition to European patent EP-B-0589877, cited opposition document D38: Roberts et al. "Directed evolution
		of a protein: selection of potent neutrophil elastase inhibitors displayed on M13 fusion phage", <i>Proc. Natl. Acad. Sci. USA</i> 89: 2429-2433 (1992)
	C71	Opposition to European patent EP-B-0589877, cited opposition document D39: Glockshuber et al. "The disulfide
		bonds in antibody variable domains: effects on stability, folding in vitro, and functional expression in <i>Escherichia coli</i> ", <i>Biochemistry</i> 31: 1270-1279 (1992)
	C72	Opposition to European patent EP-B-0589877, cited opposition document D41: Kay et al. "Phage display of
		peptides and proteins", <i>A laboratory Manual</i> (1996) (Cover page and Foreward enclosed)
	C73	Opposition to European patent EP-B-0589877, cited opposition document D42: Proba et al. "A natural antibody
		missing a cysteine in V _H : consequences for thermodynamic stability and folding", <i>J. Mol. Biol.</i> 265: 161-172 (1997)

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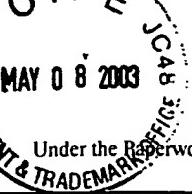


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		Applicant McCafferty et al.	RECEIVED TECH CENTER 1600 MAY 12 2003 GPO:USPTO 16217100/2000
		Filing Date November 28, 2000	
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C74	Opposition to European patent EP-B-0589877, cited opposition document D43: Proba et al. "Antibody scFv fragments without disulfide bonds made by molecular evolution", <i>J. Mol. Biol.</i> 275: 245-253 (1998)		
C75	Opposition to European patent EP-B-0589877, cited opposition document D44: Letter of 18 November 1992 to EPO from Kilburn Strode in prosecution of EP-B-0 349 578		
C76	Opposition to European patent EP-B-0589877, cited opposition document D45: Page 3 of EPO letter of 19 October 1993 addressed to Plougmann, Ole (c/o Plougmann Vingtoft A/S) in prosecution of EP-B-0 768 377		
C77	Opposition to European patent EP-B-0589877, cited opposition document D46: Letter of 22 September 1994 to EPO from Plougmann & Vingtoft in prosecution of EP-B-0 768 377		
C78	Opposition to European patent EP-B-0589877, cited opposition document D47: Extract from OD Decision in opposition proceedings against EP-B-0 201 184, (1995)		
C79	Opposition to European patent EP-B-0589877, cited opposition document D48: Letter of 14 February 1996 to EPO from Hepworth, Lawrence, Bryer & Bizley in prosecution of EP-A-0 527 839, 1996		
C80	Opposition to European patent EP-B-0589877; cited opposition document D49: the Boards of Appeal of the European Patent Office decision of 8 May 1996, case number T694/92 – 3.3.4		
C81	Opposition to European patent EP-B-0589877, cited opposition document D50: Extract from opposition proceeding against EP-B-0 349 578 (1996)		
C82	Opposition to European patent EP-B-0589877, cited opposition document D51: Extract from OD Decision in proceedings against EP-B-0 349 578 (1998)		
C83	Opposition to European patent EP-B-0589877, cited opposition document D53: Declaration of professor sir Aaron Klug, Ph.D. with exhibits, (23 June 1998)		
C84	Opposition to European patent EP-B-0589877, cited opposition document D54: preprint of paper by Scott and Smith submitted to Science		
C85	Opposition to European patent EP-B-0589877, cited opposition document D55: Smith grant application		
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	Applicant McCafferty et al.	
	Filing Date November 28, 2000	Group Art Unit 1627

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)		
C86	Opposition to European patent EP-B-0589877, late filed document D56: claim for infringement of 24 September 1998, from Cambridge Antibody Technology Limited to EPO	
C87	Opposition to European patent EP-B-0589877, late filed document D58: McConnell et al. "Constrained peptide libraries as a tool for finding mimotopes", Gene 151: 115-118 (1994).	
C88	Opposition to European patent EP-B-0589877, late filed document D59: two chapters of "Lambda II" (eds. Hendrix et al.) Cold Spring Harbour Laboratory, Cold Spring Harbour, New York, 1983: "A Beginner's Guide to Lambda Biology" (Arber) (pp. 381-395) and "Tail Assembly and Injection" (Katsura)(pp. 331-346).	
C89	Opposition to European patent EP-B-0589877, late filed document D60: Parmley & Smith "Filamentous fusion phage cloning vectors for the study of epitopes and design vaccines", Adv. Exp. Med. Biol. 251: 251-8 (1989).	
C90	Opposition to European patent EP-B-0589877, late filed document D63: Declaration of William D. Huse, MD, Ph.D. (17 August 1999	
C91	Opposition to European patent EP-B-0589877, late filed document D66: Crissman & Smith, "Gene-III protein of filamentous phages: evidence for a carboxyl-terminal domain with a role in morphogenesis", Virology 132: 445-455 (1994).	
C92	Opposition to European patent EP-B-0589877, late filed document D67: Declaration of Dr. Viia Valge-Archer (3 May, 2000)	
C93	Opposition to European patent EP-B-0589877, late filed document D68: Declaration of Dr. Hiroshi Ueda (3 May, 2000)	
C94	Opposition to European patent EP-B-0589877, late filed document D69: First Declaration of Dr. Rachel B. Kent (4 February, 2000).	
C95	Opposition to European patent EP-B-0589877, late filed document D71: letter of patentees filed at USPTO on 16 July 1996.	
C96	Opposition to European patent EP-B-0589877, late filed document D72: letter of patentees filed at USPTO on 6 March 1997.	
C97	Opposition to European patent EP-B-0589877, late filed document D73: Opposition by CAT against EP-B-0 564 531.	

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		Filing Date November 28, 2000	Group Art Unit 1627
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C98	Opposition to European patent EP-B-0589877, late filed document D74: Decision of EPOD on EP-B-0 201 184.		
C99	Opposition to European patent EP-B-0589877, late filed document D75: Declaration of Prof. Andreas Plückhun (3 May, 2000).		
C100	Opposition to European patent EP-B-0589877, late filed document D76: Notice of grant awarded to Smith grant application.		
C101	Opposition to European patent EP-B-0589877, late filed document D77: Endemann and Model "Location of filamentous phage minor coat proteins in phage and in infected cells", <i>J. Mol. Biol.</i> 250: 496-506 (1995). The document was objected to by patentees.		
C102	Opposition to European patent EP-B-0589877, late filed document D79: Extract from MorphoSys website.		
C103	Opposition to European patent EP-B-0589877, late filed document D80: Written Decision dated 26 May 2000 to revoke EP-B-0436597.		
C104	Opposition to European patent EP-B-0589877, late filed document D81: 2nd Declaration of Dr. Vila Valge-Archer (31 May, 2000).		
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